



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/783,734	01/16/97	FRIEDMAN	J 600-1-162CP2

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HM12/0120

EXAMINER

DRAPER, G

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

01/20/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

4/9-50



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This is a communication from the examiner in charge of your application.  
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## OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on Rejection of 11/1/99☐ This action is FINAL.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- ☒ Claim(s) 1-66 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-66 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d):
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

Art Unit: 1646

The reply filed on 11/1/99 is not fully responsive to the prior Office action because of the following omission(s) or matter(s): This letter of non-responsiveness is being sent because applicants have not fully complied with the written restriction requirement because the office action clearly stated that if Group IV was elected, then an election of specie was further being imposed (see page 4-5 of the previous office action in which an election is required from the various oligo's of claim 32). Furthermore, this response is considered non-responsive in response to applicant's election and the extensive traversal for rejoinder of claims, and in conjunction to the number of new claims that have been added. In view of the added claims and the extensive traversal, it would appear that applicants are interested in pursuing the examination of the new claims to methods of diagnosing for weight disorders; however, applicants also appear to elect the invention of Group IV. Therefore, clarification is requested, and the election of specie is required.

It is also pointed out that the Newly submitted claims 67-72 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The various oligo's of claims 29-33 and 49-50 can be used other than in the method of the newly presented claims. These oligo's of Group IV can be used other than in the diagnostic method of the newly added claims. In addition to their use as probes, they can also be used in various diagnostic methods. It is also pointed out while antisense and ribozymes can be used as probes, all probes can not be used as antisense and ribozymes. If applicants desire to have the method claims examined, then these claims could possibly be rejoined and examined with only the probes, **but would not be rejoined with claims to antisense or ribozymes**. It is again pointed out that an election of specie would still be probe if the probes and diagnostic method were elected

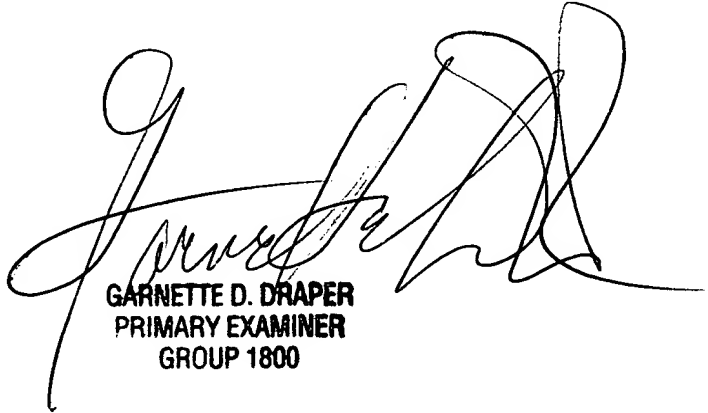
Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 67-72 would be withdrawn from consideration as being directed to a non-elected invention, if the oligo's are clearly elected as the invention for examination.

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However, if applicants desire to elect the methods of newly added claims 67-72, then this distinct Group would have to be clearly elected-separate and apart from the invention of Group IV or as stated above. See 37 CFR 1.142(b) and MPEP § 821.03. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given a **TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment.

**EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

2. Any inquiry concerning this communication should be directed to G.D. Draper at telephone number (703) 308-4232.



**GARNETTE D. DRAPER  
PRIMARY EXAMINER  
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